

## REMARKS

Prior to entry of this paper, Claims 1-29 were pending. Claims 1-29 were rejected. No amendments are made in this paper. Claims 1-29 are currently pending. For at least the following reasons, Applicants respectfully submit that each of the presently pending claims is in condition for allowance.

### Claims 9-12 and 15

Claims 9-12 and 15 were rejected under 35 U.S.C. § 102(e) as being anticipated by Harms et al. (US Publish 2003/0078981, hereinafter referred as Harms). Each of these rejections is respectfully traversed.

The rejection to Claim 9 is respectfully traversed at least because Harms fails to disclose, “accessing, over a network, an electronic archive comprising a list of e-mail addresses generated with a first application”, as recited in Applicants’ Claim 9.

The Office Action states that this limitation is met in Harms by “monitor incoming message or scan message database, incoming message is received ‘over a network’ and generated by sender application, Figures 3, paragraph [0031].” It is respectfully submitted that these actions of Harm fail to meet the limitation of Harms discussed above. “Monitoring incoming email message” is not accessing an electronic archive comprising a list of emails. Rather, it is receiving an email message sent to a user, which is much different that accessing an electronic archive comprising a list of e-mail addresses.

Scanning the user database, on the other hand, does qualify as accessing an electronic archive comprising a list of e-mails, but fails to meet other parts of the limitation, including “over a network”. In Harms, the user database on the portable device may be scanned to retrieve email addresses, but this database is not accessed “over a network” by the portable device; rather, the database is on the portable device itself, and is therefore not accessed over a network.

The Office Action states, “Second, Harms discloses receiving incoming message through a network (Figure 1, network 110, paragraph [0014]). Therefore, Harms teaches ‘accessing, over a

network, an electronic archive comprising a list of e-mail address generated with a first application". However, it is respectfully submitted that Harms only accesses the email received in this case, not an electronic archive comprising a list of e-mail addresses. The server sending the email might have an electronic archive, but if so, Harms does not have access to that electronic archive; Harms only accesses the received email.

The Office Action also stated, "Third, Harms discloses a method and apparatus 'message in a database or storage device are scanned and reviewed' (paragraph [0029], lines 3-4). Harms also discloses that device 100 communicates with network 110. Using network to access the database is inherent in the prior art. Person with ordinary skill in the art will know how to use network to access database in a server or other computers in the network. Therefore, 'over a network' is inherently taught in the prior art, the claims limitations are based on the inherent function." However, it is respectfully submitted that the issue is not whether the portable device of Harms communicates over a network, but whether or not the portable device of Harms accesses the database over a network. The database is contained in the portable device of Harms; the portable device does not access the database "over a network".

Claim 9 is respectfully submitted to be allowable for at least the reasons stated above. Claim 10-12 and 15 are respectfully submitted to be allowable at least because they depend from Claim 9.

### **Claims 21-27**

Claims 21-27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Tafoya et al. (US Patent 6,952,805, hereinafter referred as Tafoya). Each of these rejections is respectfully traversed.

Claim 21 is respectfully traversed at least because Tafoya fails to disclose, "adding the e-mail address to the electronic address book", as recited in Applicants' Claim 21. Additionally, as an independent reason for traversing the claim, Claim 21 is respectfully traversed at least because Tafoya fails to disclose, "providing to a user device, over the network, an access to the electronic address book", as recited in Applicants' Claim 21.



extract email addresses. However, it is respectfully submitted that Tafoya fails to meet the limitation because the data store is local, not remote, and therefore remote parsing of the email is not performed in Tafoya.

### **Claims 28-29**

Claims 28-29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Creswell et al. (US Patent 6,564,264, hereinafter referred as Creswell). Each of these rejections is respectfully traversed.

The rejection to Claim 28 is respectfully traversed at least because Creswell fails to disclose, “accessing a first source electronic address book for a first e-mail address” in conjunction with the limitation, “adding the e-mail address to the destination electronic address book if the first defined criterion is satisfied”, as recited in Applicants’ Claim 28.

Creswell describes updating a user’s address book. In Creswell, the **destination** is an address book in this case, but the **source** is not an electronic address book. The Office Action refers to “access address book for ‘send to’ address, Figure 3, item 303, column 4, lines 44-47.” It is respectfully submitted that it is unclear what Office Action is referring to here by accessing “address book for ‘send to’ address”. Creswell certainly does not access the address book of the sender of the email! This would be a serious violation of the sender’s privacy, assuming it were even possible! It is unlikely that this is what the Office Action means then, but it is unclear what it does mean; Creswell does not disclose accessing “address book for ‘send to’ address”.

Creswell only involves one address book, the user’s address book, as opposed to a source electronic address book and a destination electronic address book as recited in Applicants’ Claim 28.

Claim 28 is respectfully submitted to be allowable at least for at least the reasons stated above. Claim 29 is respectfully submitted to be allowable at least because it depends from Claim 28.

**Claims 1-6, 7, 8, 13, 14, and 16-20**

Claims 1-6, 8, 13 and 16-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harms in view of Tafoya. Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Harms and Tafoya as applied to claim 1, and further in view of Creswell. Claim 14 was rejected under 35 U.S.C.(a) as being unpatentable over Harms as applied to claim 12, and further in view of Cortright et al. (US Patent 6,895,426, hereinafter referred as Cortright). Each of the rejections is respectfully traversed.

It is respectfully submitted that the proposed combination of Harms and Tafoya would not have been obvious at the time the invention was made, and that the combination is based on impermissible hindsight.

Tafoya describes a system and method for populating a dynamic email resolution list. It is respectfully submitted that it would not have occurred to one of ordinary skill in the art at the time the invention was made to use the system and method of Tafoya to populate an electronic **address book**.

Tafoya states, at Col. 1, line 61 through Col. 2, line 2:

“However, many email users do not take the time to enter friendly name information into their email address books. Thus, these systems are limited by the users willingness to update and fully complete his/her email address book. Therefore, what is needed is an email system that not only utilizes email users' entries, but also other known information that is not dependent on the entries to automatically resolve email addresses.”

To solve this problem, Tafoya proposes a system and method of automatically populating a dynamic email **resolution list**; while **not changing the user's electronic address book**. With the benefit of hindsight granted by knowledge of the Applicants' invention, we see another possible solution: Tafoya could have possibly used a similar system and method to automatically update the user's electronic address book, instead of the email resolution list. This solution, however, is only evident with the benefit of impermissible hindsight.

The Tafoya reference is a Microsoft patent. Microsoft is a sophisticated company, with many well-known email-related products and services, such as Hotmail, Outlook Express, and





address book. The Office Action further states, "Cortright also discloses generated a folder within the address book and add e-mail address to the folder (column 10, lines 26-44, lines 55-61)." However, nothing in column 10 of Cortright has anything to do with address book folders.

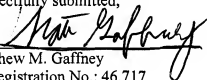
### CONCLUSION

It is respectfully submitted that each of the presently pending claims (Claims 1-29) are in condition for allowance and notification to that effect is requested. Examiner is invited to contact the Applicants' representative at the below-listed telephone number if it is believed that the prosecution of this application may be assisted thereby. Although only certain arguments regarding patentability are set forth herein, there may be other arguments and reasons why the claimed invention is patentable. Applicants reserve the right to raise these arguments in the future.

Dated: September 25, 2006

Respectfully submitted,

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